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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,228	10/16/2003	Steven D. Culhane	02-200-US2	9854
34704 7590 10/31/2008 BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510			EXAMINER HOEY, ALISSA L	
			ART UNIT	PAPER NUMBER
			3765	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/687,228

Applicant(s)

CULHANE, STEVEN D.

Examiner

Alissa L. Hoey

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 13-22 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

This is in response to amendment received on 08/12/08. Claims 10 was amended, claims 11 and 12 cancelled and claims 20-27 newly added. Claims 10 and 13-27 are examined below.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rear portion formed in it's entirety of a stretch fabric material must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 10, 13, 20-22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnston (US 6,279,161).

In regard to claims 10, Johnston discloses the following:

Claim 10. A garment (1) to be worn by a human being comprising:
a front portion and a rear portion (column 5, lines 40-42);
a pair of arms (300) being joined to said front and rear portions (column 5, lines 40-42);
each of said arms (300) having an outer elbow portion formed from a stretch fabric material (330C) and other portions (10, 20) formed from a non-stretch fabric material (column 3, lines 39-44, 50-53 and 63-65); and
underarm portions (320C) formed from a stretch fabric material (column 3, lines 39-44, 50-53 and 63-65). Further, Johnston teaches the rear portion has at least one portion

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formed from a stretch fabric material (column 5, lines 41-43: figures 2B-2F). Finally, Johnston teaches the rear portion has first and second side portions and a central portion and wherein each of said first and second side portions is formed from a stretch fabric material (column 5, lines 41-43: figures 2B-2F).

Claim 13. A garment according to claim 12, wherein said central portion (10, 20) is formed from a non-stretch fabric material (column 3, lines 39-44).

Claim 20. new) A coat garment according to claim i0, further comprising a lower rear portion formed from a non-stretch fabric material (non-stretch fabric forms the garment, including the torso and the arms: see figures 1A, 1B).

Claim 21. new) A coat garment according to claim i0, further comprising wrist portion of said garment being formed from non- stretch fabric (see figures 4E and 4F, wrist portion is formed of non-stretch fabric: also see figure 1A, 1B).

Claim 22. new) A coat garment according to claim i0, further comprising said rear portion in its entirety being formed from a stretch fabric material (when in an unstretched condition the garment is formed on the outside of the non-stretch fabric: see figures 1A, 1B).

Claim 24. new) A coat garment according to claim i0, wherein said stretch fabric material is a four way stretch fabric material (elastic is a four way stretch material).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston in view of Herlihy, Jr. (US 5,631,074).

Johnston provides a garment as described above in claim 10. However, Johnston fails to teach a liner having a stretch fabric material layer and an adjacent stretch film material layer and the liner being breathable and stretchable.

In regard to claim 14, Herlihy, Jr. teaches an athletic garment comprising a liner within the garment (figure 2, liner is layers 14, 16).

In regard to claims 15 and 16, Herlihy, Jr. provides a garment having a liner formed of a breathable waterproof stretch fabric material and an adjacent stretch film material layer next to the stretch fabric material layer (figure 2, identifiers 14, 16: column 4, lines 49-56).

It would have been obvious to have provided the athletic garment of Johnston with the liner of Herlihy, Jr., since the athletic garment of Johnston provided with a dual liner with stretchable film and fabric would provide the athletic garment with superior breathability, water fastness and stretchability keeping the user dryer, cooler, more comfortable during athletic activities.

6. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston in view of Goldsby (US 5,182,812).

Johnston provides an outer garment as described above in claim 10. However, Johnston fails to teach the outer garment having a hood that is detachable and collapsible to the outer garment.

Goldsby provides an outer garment having a hood that is detachable and collapsible to the outer garment (figures 1 and 2, identifier 12) so as to protect the user's head from the elements.

It would have been obvious to have provided the outer garment of Johnston with the removable hood of Goldsby, since the outer garment of Johnston having a detachable and collapsible hood would provide the user with a hood that can protect the wearer's head from the elements and can also be detached and stored when not needed by the wearer.

7. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston in view of Senser (US 3,335,425).

Johnston teaches a garment with stretch and non-stretch regions. However, Johnston fails to teach the garment comprising pockets and a front opening with an overlapping flap.

In regard to claim 25, Senser teaches a garment comprising a plurality of pockets located on said front portion of said garment.

In regard to claim 26, Senser teaches a garment comprising a front opening and means for closing said front opening.

In regard to claim 27, Senser teaches a piece of fabric overlapping said closing means.

It would have been obvious to have provided the stretch and non-stretch garment of Johnston with the pocket and front opening with flap of Sensor, since the stretch and non-stretch garment of Johnston provided with pockets and a front opening with flap would provide a garment that not only allows for freedom of movement, but also provides places to store items when not needed by the user and a front opening that is hidden from view to onlookers, but allows for easier donning and doffing.

Allowable Subject Matter

8. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed 08/12/08 have been fully considered but they are not persuasive.

I) Applicant argues that Johnston fails to teach a coat garment.

Examiner notes that the coat limitation in claim 10 is found in the preamble and therefore holds no structural weight in terms of patentability. Furthermore, any garment worn on the upper torso is capable of being worn as a coat garment.

II) Applicant argues that Johnston fails to teach underarm portions formed of a stretch fabric material.

Examiner disagrees, since Johnston teaches portions 320 A, 320B and 320C located along the user's underarm area.

III) Applicant argues that Johnston fails to teach a rear portion having first and second side portions formed of a stretch fabric material.

Examiner disagrees, since Johnston teaches stretch portions located along a garments arms/legs and torso portion (see column 5, lines 41-43). Therefore, a torso garment with arm portions can also have stretch portions along the shoulder joints of the garment (column 2, lines 32-34). The shoulder joints of a user would be located along the torso portion of the garment on both sides.

IV) Applicant argues that Johnston in view of Herlihy, Jr. does not disclose a motivation to create a garment with a liner.

The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the references be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPPA 1969). In this case, it is the Examiner's position that one having ordinary skill in the art would have found it obvious to combine the athletic garment of Johnston with the liner of Herlihy, Jr., since the athletic garment of Johnston provided with a dual liner with stretchable film and fabric would provide an athletic

garment with superior breathability, water fastness and stretchability keeping the user dryer, cooler, more comfortable during athletic activities.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30)Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALH

/Alissa L. Hoey/

Primary Examiner, Art Unit 3765